

**PATENT APPLICATION**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of

Docket No: Q65358

Satoshi HOSHINO

Appln. No.: 09/899,075

Group Art Unit: 3693

Confirmation No.: 3548

Examiner: Jason M. Borlinghaus

Filed: July 6, 2001

For: AUTHENTICITY CHECKER FOR DRIVER'S LICENSE, AUTOMATED-TELLER  
MACHINE PROVIDED WITH THE CHECKER AND PROGRAM RECORDING MEDIUM

**REPLY BRIEF PURSUANT TO 37 C.F.R. § 41.41**

**MAIL STOP APPEAL BRIEF - PATENTS**

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

In accordance with the provisions of 37 C.F.R. § 41.41, Appellant respectfully submits  
this Reply Brief in response to the Examiner's Answer dated September 30, 2008. Entry of this  
Reply Brief is respectfully requested.

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**STATUS OF CLAIMS**

Claims 1-15 are all the claims pending in the application. Claims 1-8 and 14-15 have been rejected, and are the subject of this appeal. Claims 9-13 are withdrawn from consideration.

**GROUND OF REJECTION TO BE REVIEWED ON APPEAL**

The issues on appeal are summarized as follows:

1. Whether claims 1-8 and 14-15 are properly rejected under 35 U.S.C. § 103(a) as being unpatentable over Kofune et al. (U.S. Patent 5,483,069; hereinafter “Kofune”) in view of the Allegedly Admitted Prior Art (AAPA).

### **ARGUMENT**

In addition to the arguments set forth in the Appeal Brief filed July 22, 2008, Appellant responds to certain points made in the Examiner's Answer as follows.

#### **Claim 1**

As set forth in the Appeal Brief file July 22, 2008, Appellant submits that Kofune, alone or in combination with the AAPA, does not disclose a driver's license image capturing module for image capturing a watermark of a driver's license from both obverse and reverse side and an authenticity judging module which judges the driver's license is a forgery if neither of the watermarks image captured from the obverse nor reverse side by the driver's license image capturing module is recognized as a regular watermark, and judges the driver's license is authentic if at least one of watermarks is recognized as a regular watermark.

In the Examiner's Answer, the Examiner asserts that the previously presented claims nor the original specification articulate a definition of claim terminology that requires a claim construction such as "a watermark on the obverse side and watermark on the reverse side".

Appellants note that on page 13, lines 9-13 of the Appeal Brief Appellant asserts that Kofune at most discloses print patterns printed on the surface of the bill and a single watermark pattern D. The print patterns and the watermark pattern D are sensed by the sensors provided on the top of the bill. Accordingly, Kofune only discloses one type of watermark sensed from one side. In contrast, the claimed invention describes capturing watermarks from obverse side and reverse side.

Furthermore, in page 1, line 20 to page 2, line 8, Applicants specification describes a “face-watermarked type driver’s license”, whose image data obtained by shooting its obverse show a clear watermark, while the image data of the reverse side do not and a “back-watermarked type driver’s license”, whose image data obtained by shooting its backside show a clear watermark, but the image data of the obverse do not. At least in view of the above, one skilled in the art would understand the features of capturing watermarks from obverse side and reverse side and how these features are distinguished from the teachings of Kofune reference, where Kofune discloses detecting patterns on the same side.

In addition, the Examiner asserts that:

even if Applicant’s assertion is correct, which the Examiner refutes, and proper claim construction requires an image capturing module located on each side of driver’s license, then such is a mere duplication of the component elements of Kofune. It has been held that mere duplication of the essential working parts of a device, without more, involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co*, 193 USPQ 8 (CA 7); *In re Harza*, 1324 USPQ 378 (CCPA 1960). (Page 8 of the Examiner’s Answer).

Furthermore, Examiner asserts “it would have been obvious to place the two image capturing modules on opposite side of the two-dimensional object, thereby capturing the image from each side.” (Page 8 of the Examiner’s Answer).

Appellant respectfully disagrees with the Examiner for at least the following reasons.

The Examiner's assertion that the image capturing module capturing for image capturing a watermark of a driver's license from both obverse and reverse side of the claimed invention are obvious because they represent "mere duplication is improper. The Examiner cites *St. Regis Paper Co. v. Bemis Co*, 193 USPQ 8 (7th Cir. 1997) and *In re Harza*, 124 USPQ 378 (CCPA 1960) in support of this assertion; however, Applicant respectfully submits the Examiner is misapplying the principles set forth in these cases. *St. Regis Paper Co.* involved the "Lokey" bag patent, for a bag entirely comprised of old elements and combinations, but which included "multiple layers" (i.e., a second bag sewed inside to provide support). The Court of Appeals explained that the Lokey bag was only entitled to a patent "if the fusion of the old elements...created a synergistic combination." The Court of Appeals held that multiple layers for strengthening a bag was not synergistic and so the Lokey bag was not entitled to protection. It was the combination that the Court looked at, not the elements themselves in determining whether the elements were patentable.

*In re Harza*, which the Examiner also relies on, stands merely for the proposition that "a plurality" of an element 'A' does not serve to distinguish an invention from prior art that teaches a single element 'A', unless it produces some new result. See *In re Harza*, 124 USPQ 380 ("The only distinction to be found is in the recitation in claim 1 of a plurality of ribs...whereas Gardner shows only a single rib...it is well settled mere duplication of parts has no patentable significance unless a new and unexpected result is produced"). As is explained on page 2 of Applicant's specification, "the conventional devices that judge the authenticity of a driver's license only by the image data of the obverse may judge an authentic back-watermarked type

driver's license to be false by mistake." Therefore, it is "an object of the present invention to judge the authenticity of a driver's license automatically no matter whether it is a face-watermarked type driver's license or a back-watermarked type one." Accordingly, to judge the authenticity of the driver's license automatically, the claimed invention recited capturing a watermark from both obverse and reverse side.

Furthermore, since Kofune does not even teach or suggest watermarks provided on either side of the bill (i.e., face-watermarked type or a back-watermarked type), it would not have been obvious to judge the authenticity of the bill (or driver's license) no matter whether it is a face-watermarked type one or a back-watermarked type one. As a result, the Examiner's grounds of rejection are based on an impermissible hindsight rationale based on the Appellant's claimed invention.

#### **Claim 14**

The Examiner asserts that "Kofune discloses that if the watermark (print pattern) on the obverse is determined not regular (insensible to infrared light), gathering second driver's license imaging data (watermark pattern) based on a watermark on the reverse side (via transmission from reverse side) of the document" (page 9 of the Examiner's Answer). To the contrary, Appellant respectfully submits that Kofune merely discloses print patterns and a watermark patterns detected from the same side of the bill; but this does not teach or suggest watermark patterns captured from obverse and reverse side of the bill.

**Claims 3 and 4**

The Examiner asserts that Kofune does disclose a first and a second camera to shoot the object from the obverse and reverse side. In contrast, Appellant respectfully submit that in column 7, lines 18-22, Kofune merely discloses a common light emitter, 4, a light detector 5 for receiving reflected light and a light detector for receiving transmitted light. However, this does not teach or suggest a first camera to shoot the driver's license from the obverse side and a second camera to shoot the drivers license from the reverse side.

**Claims 5 and 6**

In the Appeal Brief, Appellant asserted that Kofune and AAPA, alone or in combination, do not disclose a revolving means for revolving the driver's license between the lens (of the camera) and the light so that the obverse or the backside of the driver's license is placed opposite to the lens.

In response, the Examiner asserts that:

Kofune discloses a conveying means for positioning the driver's license between the lens and the light so that the obverse or the back side of the driver's license is placed opposite to the lens (see fig. 6). As evidenced by the drawings of Kofune, the conveying means is, at least in one embodiment a conveyor belt stretched between two revolving drums. The revolving drums cause the conveyor belt to turn on an axis carrying the document lying on the conveyor belt, between the lens and the light



so that the obverse of the backside of the driver's license is placed  
opposite to the lens. (See page 10 line 19-page 11, line 2).

Appellant respectfully disagrees with the Examiner for at least the following reasons.  
Appellant respectfully submit that FIG. 6 of Kofune at most discloses a conveyor means for  
conveying the driving license. Furthermore, even if, *assuming arguendo*, the alleged revolving  
drum rotates to move the conveyor belt, this still does not teach or suggest a revolving means  
that revolves the driver's license. That is, Kofune at most discloses moving the belt through the  
alleged revolving drum and not revolving the driver's license itself, as shown according to one  
exemplary embodiment in FIG. 6 of the Appellant's disclosure.

### **CONCLUSION**

For at least the reasons discussed above in addition to the reasons discussed in the July  
22, 2008 Appeal Brief, Appellants respectfully request the Board to reverse the final rejection of  
the pending claims 1-8 and 14-15. An early and favorable decision on the merits of this Appeal  
is respectfully requested.

Respectfully submitted,

/Ebenesar D. Thomas/

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Date: December 1, 2008